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PATENT APPLICATION

**RESPONSE UNDER 37 CFR §1.116
EXPEDITED PROCEDURE
TECHNOLOGY CENTER ART UNIT 2673**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

David GOLDBERG et al.

Group Art Unit: 2673

Application No.: 09/682,333

Examiner: L. Lao

Filed: August 21, 2001

Docket No.: 105864

For: MANIPULATIVE USER INTERFACE SYSTEMS AND METHODS

**REQUEST FOR RECONSIDERATION AFTER FINAL REJECTION UNDER
37 CFR §1.116**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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JAN 22 2004

Technology Center 2600

Sir:

In reply to the January 2, 2004 Office Action, please consider the following remarks.

Claims 1-11 are pending.

The Office Action rejects claims 1-3 and 5-7 under 35 USC §102(b) as anticipated by U.S. Patent No. 5,841,868 to Helbig, Sr. This rejection is respectfully traversed.

Helbig, Sr. fails to disclose, teach or suggest several positively recited features of claims 1-3 and 5-7, including storing information about the user in a physically manipulatable device, placing an object relative to the physically manipulatable device wherein relatively placing the object and the physically manipulatable device and/or physically manipulating the object communicates at least some of the stored information about the user to the responsive device.

The rejection indicates that "storing (220) information about the user in a physically manipulatable reified device" (14,30)" is disclosed in Helbig, Sr. Applicants respectfully disagree. Moreover, Applicants assert that this statement in the rejection is unclear in the sense that, while element 220 in Helbig, Sr. is a storage device (a ROM), it is not a physically manipulatable device, as recited in claims 1, 3, 5 and 7. The Office Action identifies the alleged physically manipulatable device as either the keyboard 14 or the card reader 30. However, the ROM 220 is not part of the keyboard 14 or the card reader 30 and Helbig, Sr. does not teach storing information about a user in the keyboard 14 or in the card reader 30.

Moreover, placing an object such as a card 34 relative to the keyboard 14 or the card reader 30 in Helbig, Sr. is not placing an object relative to a physically manipulatable device to accomplish the recited communication because neither the keyboard 14 nor the card reader 30 is a physically manipulatable device that stores information about a user.

Furthermore, with respect to claim 3, which is the only claim of claims 1-3 and 5-7 that recites a reified device, reification is a process by which concepts are turned into objects. For example, in a graphical editing tool, the concept of a circle is represented as an image of a circle in a tool palette. In other words, the concept of a circle is reified into a tool. Reification creates new objects that can be manipulated by the user.

Helbig, Sr. is totally devoid of any disclosure or suggestion of reification or turning concepts into objects, and neither the keyboard 14 nor the card reader 30 is disclosed as a reified device. Thus, Helbig, Sr. does not anticipate claim 3.

Accordingly, Helbig, Sr. does not anticipate claims 1-3 and 5-7.

The Office Action rejects claims 1-3 and 5-7 under 35 USC §102(e) as anticipated by U.S. Patent No. 6,137,480 to Shintani. This rejection is respectfully traversed.

Claims 1-3 and 5-7 patentably define over Shintani, whose keyboard 3 is allegedly a physically manipulatable reified device.

Initially, Applicants respectfully submit that the rejection is not clear in the sense that it refers to the "object" that is placed relative to the manipulatable reified device as "2" in one instance and as "34" in another instance. In Shintani, element 2 is a "portable non-contact card" There is no element 34. Under the circumstances, Applicants will construe the use of "34" as a typographical error and respond to the rejection considering element "2" as the "object" that is placed relative to the manipulatable reified device.

Shintani does not store information in the keyboard 3 as asserted by the Office Action and, thus, does not disclose storing information about a user in a physically manipulative device, as recited in claims 1, 3, 5 and 7. Moreover, Shintani does not disclose communicating information stored in a physically manipulatable device (alleged to be the keyboard 3) to its responsive device (alleged to be the computer and the display 4) based on relatively placing the non-contact card 2 and the physically manipulative device (alleged to be keyboard 3) and/or physically manipulating the object card 2.

Furthermore, with respect to claim 3, which recites a reified device, as discussed above, reification is a process by which concepts are turned into objects. Shintani is totally devoid of any disclosure or suggestion of reification or turning concepts into objects, and the keyboard 3 is not disclosed as a reified device. As a result, Shintani does not anticipate claim 3.

Accordingly, Shintani does not anticipate claims 1-3 and 5-7.

The Office Action rejects claims 4 and 8-10 under 35 USC 103(a) as unpatentable over Helbig, Sr. or Shintani in view of U.S. Patent 5,845,265 to Woolston. This rejection is respectfully traversed.

Neither Helbig, Sr. nor Shintani disclose a manipulatable reified device, as recited in claim 4, for reasons discussed above with respect to claim 3.

Neither Helbig, Sr. nor Shintani disclose the features of claims 8-10 for reasons set forth above with respect to claim 7 from which they depend.

Woolston pertains to selling products to consumers who may charge purchases with a credit card. Neither Helbig, Sr. nor Shintani deal with selling products to consumers who may charge purchases with a credit card. Absent such a teaching in Helbig, Sr. or in Shintani, there is no proper motivation to use a credit card number as a user asset to be stored in Helbig, Sr. or Shintani.

Instead of providing a reason why one of ordinary skill in the art would have been motivated to combine these references, the Office Action merely states the results of. This omits the essential requirement of a motivation for one to have looked to Woolston to modify Helbig, Sr. or Shintani.

In rebuttal, the Office Action indicates that Woolston discloses that the credit card number can be used as an ID number to access a computer.

Applicants respectfully that Woolston's disclosure is more limited than as stated in the rebuttal argument. Woolston only discloses using a credit card number in the context of a computer that is used for consigning, buying and selling goods. This context is not disclosed or suggested by Helbig, Sr. or Shintani.

Accordingly, the rejection fails to make out a prima facie case of obviousness of the invention recited in claims 4 and 8-10. Thus, the rejection is improper, and should be withdrawn.

Moreover, even if it were proper to combine these references, which it is not, the resulting reference combination would not have rendered the invention recited in the claims

obvious because of the aforementioned fundamental shortcomings of Helbig, Sr. and/or Shintani.

Accordingly, withdrawal of the rejection of claims 4 and 8-10 is respectfully requested.

The Office Action rejects claim 11 under 35 USC §103(a) as unpatentable over Shintani in view of U.S. patent 6,257,984 to Gershon. This rejection is respectfully traversed.

Claim 11 depends from claim 1 and is patentable at least for the reasons that claim 1 is patentable over Shintani, as discussed above.

Gershon discloses a push-button operated video game mounted on a hat. The rejection fails to explain how this is reasonably pertinent to the particular problem with which Shintani is involved. Shintani is concerned with managing operations of plural computer terminals with a non-contact card. This appears to have nothing to do with playing video games in any context, let alone video games mounted on a hat.

The conclusion that it would have been obvious in view of Gershon to modify Shintani (in a totally unspecified manner) based on Gershon's teaching in col. 1, lines 31-35 ("that underlying the present [Gershon] invention is the recognition that a light display-bearing cap, and also of course one without such an adornment, has cap-on and cap-off wearing positions, the former the better for presenting a display to passerby and also obviating loss and damage to the display . . .") is not supported by any objective evidence or reasoning. A factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusionary statements of the Examiner. See, In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). As neither applied reference even suggests reification or a manipulatable reified device, the motivation for modifying Shintani

to include creating and transferring reconstruction data must be based on speculation and/or impermissible hindsight.

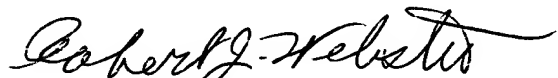
Applicants respectfully submit that Gershon is classical "non-analogous" art to Shintani.

In view of the foregoing, it is respectfully submitted that the rejection of claim 11 is improper and should be withdrawn.

Accordingly, Applicants respectfully submit that claims 1-11 are patentable over the applied art and should be allowed. Favorable reconsideration and prompt allowance are earnestly solicited.

Should the Examiner believe that anything further is desirable to place the application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,



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JAO:RJW/sxb

Date: January 16, 2004

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